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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/874,514	06/05/2001	Samuel J. Danishefsky	2003080-0082 (SK-744-US/C)	6697
24280	7590	11/28/2001		

Choate, Hall & Stewart
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Boston, MA 02109

EXAMINER

SOLOLA, TAOFIQ A

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 11/28/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/874,514

Applicant(s)

Danishefsky et al.

Examiner

Taofiq A. Solola

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE one MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-58 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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DETAILED ACTION

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1, 3, 5, 7, 30-33, 45-58, drawn to compounds having no heterocyclic ring at position R'', their composition and methods of use, classifiable in class 549, subclass 266+.
- II. Claims 1-8, 30-33, 45-58, drawn to compounds having thiazoline at position R'', their composition and methods of use, classifiable in class 548, subclass 29+.
- III. Claims 1, 3, 5, 7, 30-33, 45-58, drawn to compounds having furan at position R'', their composition and methods of use, classifiable in class 549, subclass 497+.
- IV. Claims 1, 3, 5, 7, 30-33, 45-58, drawn to compounds having no pyridyl at position R'', their composition and methods of use, classifiable in class 546, subclass 268.1+.
- V. Claims 1, 3, 5, 7, 30-33, 45-58, drawn to compounds having imidazole at position R'', their composition and methods of use, classifiable in class 548, subclass 300+.
- VI. Claims 1, 3, 5, 7, 30-33, 45-58, drawn to compounds having oxazole at position R'', their composition and methods of use, classifiable in class 548, subclass 215+.

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- VII. Claims 1, 3, 5, 7, 30-33, 45-58, drawn to compounds having indole at position R'', their composition and methods of use, classifiable in class 548, subclass 465+.
- VIII. Claims 9-10, 15, drawn to compounds classifiable in class 568, subclasses 578+, 840+.
- IX. Claims 11-12, 17, drawn to compounds classifiable in class 548, subclass 200+.
- X. Claims 13-14, 16, drawn to compounds classifiable in class 568, subclasses 907+, 913+.
- XI. Claims 18-20, drawn to process of making compounds Z-haloalkene classifiable in classes 560, 568, subclass 202+.
- XII. Claims 21-24, drawn to process of making intermediate compounds classifiable in class 548, subclass 202+.
- XIII. Claim 25, drawn to process of making open-chain aldehydes classifiable in class 548, subclass 201+.
- XIV. Claim 26, drawn to process of making epothilone classifiable in class 548, subclass 194+.
- XV. Claims 27-29, drawn to process of making epothilone precursor classifiable in class 548, subclass 193+.

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- XVI. Claim 34, drawn to process of making Z-iodoalkene classifiable in class 548, subclass 203+.
- XVII. Claims 35-36, drawn to 2nd process of making open-chain aldehyde classifiable in class 548, subclass 201+.
- XVIII. Claims 37-38, drawn to process of making protected epothilone classifiable in class 548, subclass 194+.
- XIX. Claims 39-40, drawn to 2nd process of making epothilone classifiable in class 548, subclass 194+.
- XX. Claims 41-42, drawn to process of making cyclic diol classifiable in class 548, subclass 200+.
1. The inventions are distinct, each from the other because of the following reasons: The inventions of groups I-X are independent and distinct because, there is no patentable co-action among the various groups, and a reference anticipating one member will not render another obvious.
 2. The inventions of groups XI-XX are independent and distinct because, there is no patentable co-action among the various groups, and a reference anticipating one member will not render another obvious.
 3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

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A telephone call was made to Karoline Shair on 11/16/01 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Taofiq A. Solola whose telephone number is (703) 308-4690. The examiner is on flexible work schedule and is generally out of the office on Wednesdays.

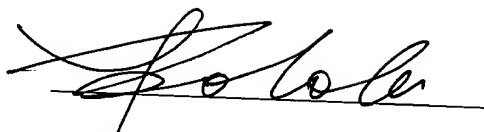
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph McKane, can be reached on (703) 308-4537. The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

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A handwritten signature in black ink, appearing to read 'Solola', written over a horizontal line.

Taofiq A. Solola, Ph.D.

Primary Examiner

Group 1626

November 23, 2001